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OFFICE OF PETITIONS

In re Application of
DeMasi
Application No. 09/845,999
Deposited: April 30, 2001
FOR: UNIVERSAL FLYING HAWK

: DECISION DISMISSING
: PETITION

This is a decision on the petition, filed on July 30, 2001, requesting that the above-identified application be accorded a filing date of April 30, 2001, and that the Notices of Incomplete Nonprovisional Application, mailed for this application on June 25, 2001 ("6/25/01 Notice") and July 20, 2001 ("7/20/01 Notice"), be withdrawn.

The petition is **DISMISSED**.

The application was deposited on April 30, 2001. However, the Office of Initial Patent Examination (OIPE) mailed the 6/25/01 Notice, stating that this application had not been accorded a filing date because it was deposited without a specification. In a July 2, 2001 letter to the Customer Service Center of OIPE, Applicant requested reconsideration of the 6/25/01 Notice.¹ Applicant asserted in that letter that the present application was a "continuation-in-part application (CIP) filed according to the provisions set forth in 37 CFR 1.62(e)," and that for purposes of filing date, the preliminary amendment filed on April 30, 2001 would have sufficed. The 7/20/01 Notice then followed, reiterating that this application had not been accorded a filing date because it was deposited without a specification.

In response, the present petition was filed. Petitioner again asserts in essence that the application, being a CIP filed "according to the provisions set forth in 37 CFR 1.62(e)," would have met the filing date requirements when filed with an amendment to the prior application rather than a complete specification. The petition thus requests the April 30, 2001 filing date solely based on the fact that a preliminary amendment in lieu of a specification was filed on that day.

A review of the application papers deposited on April 30, 2001 reveals that the papers included an application transmittal letter (form PTO/SB/05) identifying the papers as a new nonprovisional application under 37 CFR 1.53(b). The preliminary amendment deposited on April 30, 2001, at page 1, also identifies the papers as "a continuation-in-part application under 37 CFR 1.53(b)(2)." Thus, this application was deposited as an application under 37 CFR 1.53(b), **not** under 37 CFR

¹ The letter was improper since the 6/25/01 Notice specifically provided that any disputes concerning the notice must be addressed in a petition under 37 CFR 1.53(e) and be directed to the Office of Petitions.

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1.62, as asserted in the July 2, 2001 letter and in the present petition. Furthermore, 37 CFR 1.62 was deleted effective December 1, 1997 (see MPEP 201.06(b) (8th Ed., Aug. 2000)). Therefore, it was not possible to file an application under 37 CFR 1.62 on April 30, 2001.

This application still lacks a specification as required by 35 U.S.C. 112 and remains incomplete.² The petition is thus dismissed. The Office notes, however, that Applicant filed a Second Preliminary Amendment and a Third Preliminary Amendment on September 19 and 24, 2001, respectively. The Third Preliminary Amendment specifically incorporates the specification and the drawings of the prior application, No. 09/313,566, by reference.³

Applicant is given **TWO MONTHS** from the mailing date of this decision to file a renewed petition under 37 CFR 1.53(e), if so desired, requesting that the application be accorded a filing date of September 24, 2001, the day the Third Preliminary Amendment was filed incorporating the disclosure of the prior application. To be granted, such renewed petition must be accompanied by a copy of the specification and drawings as originally filed in the prior application. In addition, in light of the remaining new matter disclosed in the CIP, a newly executed oath or declaration referring to this application by application number and the September 24, 2001 filing date is required under 37 CFR 1.63(e).

Moreover, the prior application, No. 09/313,566, became abandoned on May 1, 2001 for failure to timely submit a proper reply to the January 31, 2001 final Office Action. As a means of benefiting from the prior application filing date under 35 U.S.C. 120, Applicant may promptly file a petition under 37 CFR 1.137 to revive this prior application in order to establish continuity between the parent application and the CIP.

² The filing date of a nonprovisional application is defined in 35 U.S.C. 111 as the date of receipt by the USPTO of a specification as prescribed by 35 U.S.C. 112 and any necessary drawings required by 35 U.S.C. 113. Specifically, section 112 requires the specification to:

"contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention"; (first paragraph) and

"conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." (second paragraph)

The CIP filed on April 30, 2001 includes a preliminary amendment which contains at least 1 claim, e.g., the added Claim 43 on page 6, but lacks such a written description of the invention as required by the first paragraph of 35 U.S.C. 112.

Failure to file a renewed petition or to otherwise complete this application within **TWO MONTHS** of the mailing date of this decision will result in the return of the application to OIPE for refund of the filing fee, less the \$130 handling fee set forth in 37 CFR 1.21(n), and for final processing as an incomplete application under 37 CFR 1.53(e)(3) (Failure to meet filing date requirements). This two-month period **may not be extended under 37 CFR 1.136.**

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.



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